

NE000018C1

PTO/SB/26 (09-08)

**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING
REJECTION OVER A "PRIOR" PATENT**Docket Number (Optional)
019957-011212US

In re Application of: James C. Paulson et al.

Application No.: 10/081,455

Filed: February 21, 2002

For: PRACTICAL IN VITRO SIALYLATION OF RECOMBINANT GLYCOPROTEINS

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The owner, Neose Technologies, Inc., of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term prior patent No. 5,399,336 as the term of said prior patent is defined in 35 U.S.C. 154 and 173, and as the term of said prior patent is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the prior patent, "as the term of said prior patent is presently shortened by any terminal disclaimer," in the event that said prior patent later:

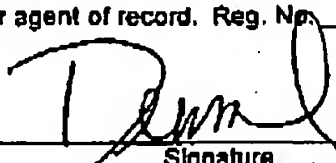
- expires for failure to pay a maintenance fee;
- is held unenforceable;
- is found invalid by a court of competent jurisdiction;
- is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;
- has all claims canceled by a reexamination certificate;
- is reissued; or
- is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☒ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☐ The undersigned is an attorney or agent of record. Reg. No. _____



Signature

12/18/06
DateDebra J. Poul, Senior Vice President & General Counsel
Typed or printed name215-315-9000
Telephone Number

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) is included.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).
Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

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~~12/26/2006 HDEHESS1 00000059 201430 10001455~~~~01 FC:2814 65.00 DA~~

12/28/2006 HDEHESS1 00000005 201430 10001455

01 FC:2814 65.00 DA

PTO/SB/17 (07-06)

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL

For FY 2006

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 130

Complete if Known

Application Number 10/081,455
 Filing Date February 21, 2002
 First Named Inventor Paulson, James C. et al.
 Examiner Name Rao, Manjunath N.
 Art Unit 1652
 Attorney Docket No. 019957-011212US

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METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____
☒ Deposit Account Deposit Account Number: 20-1430 Deposit Account Name: Townsend and Townsend and Crew LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee
☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

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FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Small Entity	Small Entity	Small Entity	Small Entity	Small Entity	Small Entity	
	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description

Each claim over 20 (including Reissues)

Each independent claim over 3 (including Reissues)

Multiple dependent claims

Total Claims Extra Claims Fee (\$) Fee Paid (\$)
 -20 or HP = _____ x _____ = _____

HP = highest number of total claims paid for, if greater than 20

Indep. Claims Extra Claims Fee (\$) Fee Paid (\$)
 -3 or HP = _____ x _____ = _____

HP = highest number of independent claims paid for, if greater than 3

Small Entity	
Fee (\$)	Fee (\$)
50	25
200	100
360	180
Multiple Dependent Claims	
Fee (\$)	Fee Paid (\$)

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets Extra Sheets Number of each additional 50 or fraction thereof Fee (\$) Fee Paid (\$)
 - 100 = _____ / 50 = _____ (round up to a whole number) x _____ = _____

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g. late filing surcharge): Terminal Disclaimer

Fees Paid (\$)

130

SUBMITTED BY

Signature Jennifer L. Wadsten Registration No. 46,226 Telephone 415-576-0200
 Name (Print/Type) Jennifer L. Wadsten Date Dec 20, 2006

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S. Wadsten

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Tel 206 467-9600

DEC 20 2006

San Francisco

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Eighth Floor
San Francisco
California 94111-3834
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FACSIMILE COVER SHEET

Date: December 20, 2006	Client & Matter Number: 019957-011212	No. Pages (including this one): 4
To: Examiner Manjunath Rao USPTO	At Fax Number: 571-273-0939	Confirmation Phone Number: 571-272-0939
From: Jennifer L. Wahlsten		(2817)

Message:

Re: Application No. 10/081,455
Filed: February 21, 2002
Title: *Practical In Vitro Sialylation of Recombinant Glycoproteins*

Dear Examiner Rao,

As promised in our recent telephone discussion, enclosed is a copy of the Terminal Disclaimer and Statement Under 3.73(b) which we filed today via EFS-Web with the PTO.

Yours truly,

Jennifer Wahlsten
Reg. No. 46,226

Original Will:	<input type="checkbox"/> BE SENT BY MAIL	<input type="checkbox"/> BE SENT BY FEDEX/OVERNIGHT COURIER	<input type="checkbox"/> BE SENT BY MESSENGER	<input checked="" type="checkbox"/> NOT BE SENT
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Faxed:

Return to: Brenda J. Dolly - (4211)

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Important

This message is intended only for the use of the individual or entity to which it is addressed and may contain information that is privileged, confidential, and/or exempt from disclosure by applicable law or court order. If the reader of this message is not the intended recipient, or the employee or agent responsible for delivering the message to the intended recipient, you are hereby notified that any dissemination, distribution, or copying of this communication is strictly prohibited. If you have received this communication in error, please notify us immediately by telephone and return the original message to us at the above address via the United States Postal Service. Thank you.

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PTO/SB/96 (12-05)

Attorney Docket No. 019957-011212US

STATEMENT UNDER 37 CFR 3.73(b)Applicant/Patent Owner: PAULSON et al.Application No./Patent No./Control No.: 10/081,455Filed/Issue Date: February 21, 2002RECEIVED
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DEC 20 2006

Entitled: PRACTICAL IN VITRO SIALYLATION OF RECOMBINANT GLYCOPROTEINS

Neose Technologies, Inc.

(Name of Assignee)

a Corporation

(Type of Assignee: corporation, partnership, university, government agency, etc.)

states that it is:

1. ☐ the assignee of the entire right, title, and interest; or
2. ☐ an assignee of less than the entire right, title and interest.
(The extent (by percentage) of its ownership interest is _____%)

in the patent application/patent identified above by virtue of either:

- A. ☐ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or a true copy of the original assignment is attached.

OR

- B. ☒ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as follows:

1. From: Cytel Corporation To: Neose Technologies, Inc.
The document was recorded in the United States Patent and Trademark Office at
Reel 012884, Frame 0398, or for which a copy thereof is attached.
2. From: James Paulson et al. To: Cytel Corporation
The document was recorded in the United States Patent and Trademark Office at
Reel 8381, Frame 0781, or for which a copy thereof is attached.
3. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

As required by 37 CFR 3.73(b)(1)(i), the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11

[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, to record the assignment in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.


Signature

Debra J. Poul

Printed or Typed Name

Senior Vice President & General Counsel

Title

12/18/06
Date215-315-9000
Telephone Number

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